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| APPLICATION NO.   | FILING DATE     | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|---|-----------------|----------------------|------------------------------|------------------|
| 09/994,078  | 11/26/2001      | William Brown        | P 282437<br>ABA-300/13004-4- | 2807             |
|   | 7590 05/18/2004 |                      | EXAMINER<br>BORIN, MICHAEL L |                  |
| Fitch, Even, Tabin & Flannery<br>1801 K Street, N.W.<br>Suite 401L<br>Washington, DC 20006-1201 |                 |                      | ART UNIT                     | PAPER NUMBER     |
|   |                 |                      | 1631                         |                  |

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/994,078 | <b>Applicant(s)</b><br>BROWN ET AL. |  |
|                              | <b>Examiner</b><br>Michael Borin     | <b>Art Unit</b><br>1631             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 09 March 2004.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-29, 51 and 54 is/are pending in the application.  
4a) Of the above claim(s) 16, 52 and 53 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-15, 17-29, 51, 54 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Status of Claims*

Response filed 03/09/2004 is acknowledged.

Claims 1-29,51,54 are pending. Claims reading on the elected species, compound H-Tyr-D-Arg-D-Phe-Phe-NH<sub>2</sub>, are 1-15,17-29, 51,54. Claims 16, 52,53 are withdrawn from consideration as drawn to non-elected species (it seems that applicant considers these claims as canceled).

### *Priority*

Examiner maintains that priority of this application goes back to the immediate parent, 09/159518, with the priority date of 09/24/1998. Applicant is not granted with priority date of previous application 09/718585 as there are no common applicants in the instant and referenced applications, and no applicant was deleted in the course of prosecution of application 09/718585.

Applicant refers to the Example in MPEP 201.03. However, unlike the situation described in the Example, no applicant was deleted in the course of prosecution of application 09/718585. Consequently, as there are no common applicants in the instant and referenced application, applicant is not granted priority date of previous application 09/718585.

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Further, applicant submits that Dr. Wang, the sole inventor of 09/718585, has signed the declaration of the parent application 09/159518. Examiner agrees, and notes that the priority of this parent application was granted as explained in the previous Office action.

***Claim Rejections - 35 USC § 102.***

The rejections of record over Wang et al, and Saenger et al are maintained. The rejections are maintained because priority of 09/159518 remained denied for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

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of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (571) 272-0722.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0549.

May 12, 2004

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

mlb

